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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,006	07/10/2000	Mark A. Schena	M-9216 US	9156

7590 08/26/2003
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EXAMINER

FORMAN, BETTY J

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/613,006	Applicant(s) SCHENA, MARK A.	
	Examiner BJ Forman	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 28-46.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Interview Summary of 4 August 2003


Continuation of 2. NOTE:

The amendments include limitations not previously presented or considered. The amendments include limiting the probe mixture to "consist" of oligos of known sequence and length and selected from "a group consisting of" complementary to a marker for a 1) gene; 2) for one or more allelic variants of the gene; and 3) a gene and one or more allelic variants of the gene wherein "a hybridization signal indicates" genotype. Because these limitations were not previously presented, they were not previously considered. Therefore, the amendments would require further search and consideration.

Response to Applicant's remarks:

Applicant argues that the previous recitation "consisting essentially of" is not equivalent to comprising as stated in the Final Office Action. Applicant further states that there is not ambiguity as to oligonucleotide mixture because the mixture is clearly recited in Claim 28 to be oligos of known sequence and length. The arguments have been considered but are not found persuasive because as stated in the previous action, the courts have stated that absent a clear indication in the specification or claims as to the novel characteristics, "consisting essentially of" will be interpreted as "comprising" (MPEP 2111.03). Applicant has not pointed to any "clear indication", other than the claim recitation itself, as to the definition or meaning of "consisting essentially". Furthermore, Applicant has not pointed to any teaching in the specification which would define how the phrase "consisting essentially of" modifies the claimed oligonucleotide mixture. Because the courts have stated that, absent a clear indication of the meaning of "consisting essentially of", the phrase will be interpreted as "comprising" and because the specification and claims do not define or describe how "consisting essentially of" modifies the oligonucleotide mixture, the phrase is interpreted as comprising and encompasses the additional oligonucleotides of Drmanac.

Applicant argues that the cited prior art does not teach a hybridization signal indicates genotype as recited in the amended claims. The argument has been considered but is deemed moot because the amendments have not been entered. Therefore the argument is not relevant to the previous rejection.


BJ FORMAN, PH.D.
PRIMARY EXAMINER